

08CL7395-11

REMARKS

Claims 1 – 32 are pending in the present Application. No claims have been canceled, amended, or added, leaving Claims 1 – 32 for consideration. Reconsideration and allowance of the claims is respectfully requested in view of the enclosed terminal disclaimer and the following remarks.

Claim Rejections Under 35 U.S.C. §101

Claims 1, 4 – 20, and 25 – 32 stand rejected under 35 U.S.C. §101 as allegedly claiming the same invention as that of Claims 1, 3 – 18, 20 – 23, and 28 – 30, of U.S. Patent No. 6,733,950 to Breitung et al. Applicants respectfully traverse this rejection.

As stated in the Office Action, Page 2, “[t]he term ‘same invention,’ in this context, means an invention drawn to identical subject matter.” [citations omitted] It is noted that double patenting can be determined by asking:

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

(MPEP 804.II.A)

Claim 1 of the present application claims a limited play optical storage media. The media comprises: an optically transparent substrate, a reflective layer, an oxygen penetrable UV coating disposed on a side of said substrate opposite said reflective layer, and a reactive layer disposed between said UV coating and said substrate. The optical storage media has an initial percent reflectivity of about 50% or greater and a subsequent percent reflectivity of about 45% or less.

Claim 1 of Breitung et al. also claims a limited play optical storage media. This media comprises: an optically transparent substrate, a reflective layer, a data storage layer disposed between said substrate and said reflective layer, an oxygen penetrable UV coating disposed on a side of said substrate opposite said data storage layer, and a reactive layer disposed between said UV coating and said substrate. The optical storage media has an initial percent reflectivity of about 50% or greater and a subsequent percent reflectivity of about 45% or less.

08CL7395-11

Hence, a media that has an optically transparent substrate, a reflective layer, an oxygen penetrable UV coating disposed on a side of said substrate opposite said reflective layer, and a reactive layer disposed between said UV coating and said substrate, and wherein the optical storage media has an initial percent reflectivity of about 50% or greater and a subsequent percent reflectivity of about 45% or less, but does not have a data storage layer disposed between the substrate and the reflective layer, will literally infringe the present application and not literally infringe Breitung et al.

Similarly, the method claims of Breitung et al. include the element wherein at least a portion of said light passes through a data storage layer; while the present method claims do not include this element. Hence, these claims are also not identical to the claims of Breitung et al.

Considering that none of the independent claims, and therefore by definition, none of the dependent claims of the present application are identical to the claims of Breitung et al., the present application is not the "same invention". Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections Under Obviousness-type double patenting

Claims 1, 4 – 21, and 25 – 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1 – 32 of Breitung et al. Claims 1, 4 – 21, and 23 – 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1 – 32 of Breitung et al. in view of U.S. Patent No. 4,983,505 to Higuchi et al. Claims 1, 4 – 22, and 25 – 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1 – 32 of Breitung et al. in view of U.S. Patent No. 6,168,844 to Takagishi et al. Claims 1 – 22 and 25 – 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1 – 32 of Breitung et al. in view of EP 0274092 to Kanno et al. and/or U.S. Patent No. 4,997,903 to Okamoto. Claims 1 – 32 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over Claims 1 – 32 of Breitung et al. view of Kanno et al., and/or Okamoto combined with Takagishi et al. or Higuchi et al. Applicants are filing a terminal disclaimer

08CL7395-11

herewith, thereby rendering these rejections moot. Reconsideration and withdrawal of these rejections are respectfully requested.

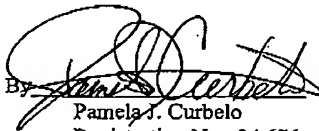
Applicants note, however, that "a reflectivity afterwards as being 45%" is not inherent and a mere recitation of similar elements would not render any of the present claims anticipated or obvious. However, Applicants do not understand the comment as set forth in the Office Action: "claims 20 and 28 of the reference recite all of the materials limitations of the instant claims, but do not describe the reflectivity afterwards as being 45%". (Page 2) This is confusing since the last cited element of Claim 20 of Breitung et al. is: "reducing the percent reflectivity of said data storage media to less than about 45%", and since Claim 28 depends from Claim 20.

It is believed that the foregoing remarks fully comply with the Office Action and that the claims herein are allowable to Applicants. Accordingly, reconsideration and withdrawal of the rejections and allowance of the case are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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